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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,371	08/13/2001	Heiko Dassow	2345/161	9518

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EXAMINER

PESIN, BORIS M

ART UNIT PAPER NUMBER

2174

DATE MAILED: 10/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/913,371

Applicant(s)

DASSOW ET AL.

Examiner

Boris Pesin

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 6 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 13-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 13-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

In regards to claim 13, the inventor does not clearly define the term value tree. In the "field of invention" section, the value tree is broadly defined to mean, "values of data types of a formally defined data structure." This definition is not a sufficient one due to the fact that all data structures contain values of data types; therefore any data structure would be considered, by that definition, to be a value tree.

Further in regards to claim 13, the inventor claims that the invention provides, "at least one of a graphical representation and a textual representation of the value is selectable for each subtree of the value tree." However, Figure 1 shows the `baseManagedObjectClass` with the corresponding button (element 6) in the minus (-) position. As per the specification, the minus designates that the object is textually represented. However, it is not clear to the examiner how `baseManagedObjectClass` is

textually represented in Figure 1. The same rationale applies to the node named GetArgument SEQUENCE and its corresponding button (element 5).

Further in regards to claim 13, it was never made clear in the description or in drawings how one would textually represent an object such as GetArgument or baseManagedObjectClass and further encapsulate one in the other.

In regards to claim 16, the inventor does not clearly specify in the detailed descriptions what is meant by "processing." The examiner does not know where these values will be processed, and for what purpose. The inventor claimed that the invention deals with "A method for graphically representing a value of a data type of a formally defined data structure existing as a value tree", as stated in claim 13, therefore the examiner does not know where the processing would occur.

Further in regards to claim 16, it is not made clear to the examiner what is meant by the statement, "at least one of data and the value list is initialized".

In regards to claim 17, it is not clear to the examiner where and how the value is "transferred". The specification states, "... values may be transferred from one subtree into another by intermediately storing and clicking on the subtree in question."(page 4, Line 31). However there is no mention of how the values to be transferred will be selected, or how the values will be transferred in a "transfer syntax", as per claim 17.

In regards to claim 19, the inventor does not clearly specify where the user would input information as to whether the exact type assignment should be performed.

Further in regards to claim 19, it is not made clear to the examiner what is meant by the statement, "should be performed one of automatically and following a manual input".

In regards to claim 20, the inventor does not clearly specify in the detailed descriptions, what is meant by "intermediately storing and clicking on the subtree."

In regards to claim 22, the inventor does not clearly specify in the detailed descriptions, what is meant by "storable." The examiner does not know whether this information will be stored on a particular medium or be integrated within the GUI.

Further in regards to claim 22, the examiner does not know what "additional information to be displayed" the inventor is referring to.

2. Claims 16, 17, 19, 20, and 22-26 are not going to be addressed^d with respect to prior art due to the 112 1st paragraph rejections. ←←

3. Claim 13-26 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01.

The omitted elements are:

In regards to claim 13, the inventor does not specify where values will be inputted, however this information is necessary for its dependant claims.

In regards to claim 23, essential elements are missing from claim 13 to support claim 23. Claim 23 discusses "inputting of values", however there is no mention of inputting of values in its parent claim. Claim 13 only discusses selecting of information, and there is no mention of inputting of information.

Since claim 24 discusses inputting of values, as in claim 23, it is rejected under similar rationale.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Because claims 13-15, 18, and 21 are being rejected under 35 U.S.C. 112 first paragraph, the examiner attempted to comprehend the invention to the best of his abilities given the lack of detailed specification. Terms that were not clearly defined within the specification were interpreted to mean the broadest possible definition.

5. Claim 13, 18, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Ebert (US 6,278,991).

In regards to claim 13, Ebert discloses a browser that “conveys data in an efficient manner by displaying the data according to the data’s hierarchical structure.”(Column2, line 27, and Figure 1). Ebert further discloses at least one graphical user interface component is in a recognizable relation to at last one node of the value tree. (Figure 1, Elements 26, and 20) Ebert further discloses a textual representation and a graphical representation of the value for each subtree of the value tree. (Figure 1, Element 10) Those representations are selectable by the user with the mouse. The user can go from the textual name of the node to the complete visual layout of the node by clicking, or selecting, the appropriate node.

In regards to Claim 18, Ebert discloses a data type that is inserted in a dynamically changeable subtree in the value tree represented by the graphical user-interface (Figure 1, Elements 12, 14, 16, and 18).

In regards to Claim 21, Ebert discloses that, “the invention may be designed as modules that can be imbedded in a container”. (Column 4, line 44)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ebert (US 6,278,991) in view of Michael Brydon.

With respect to claim 14, Ebert discloses the limitations of claim 13, but does not disclose deriving for each node a value list of values compatible with respect to assignment with the data types, and selection one of the values from the values list for each value assignment. Brydon teaches, "A combo box is list of values from which the user can select a single value." A combo box is a data type with predefined attributes; therefore the user is given a choice of values for that particular data type. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a combo box data field, or value list, in Ebert's invention and modify it to include a combo box data field, or value list, in order for a value to be selected from the list of different values.(Brydon, Page 1, Section 8.1)

Claim 15 additionally recites the ability to restrict the number of values to be accepted on the list. Brydon teaches that the combo box, or value list, can have predefined attributes based on the user requirements.(Page 1, Section 8.1)

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. :

Arazi, B. "Binary-to-Decimal conversion based on the divisibility of $2^n - 1$ by 5",
Electronic Letters, 11/5/92.

Lewis, et. al. US 5,987,469

Stodghill, et. al. US 5,710,901

Bernhardt, et. al. US 6,496,208

McGurrin, et al. US 5,913,063

Franke, et al. US 4,710,763

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boris Pesin whose telephone number is (703)305-8774. The examiner can normally be reached on Monday-Friday 8-6, with the exception of every other Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on (703)308-0640. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Kristine Kincaid
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